

REMARKS

In the Office Action¹, the Examiner took the following actions:

rejected claims 25 and 27 under 35 U.S.C. § 112 second paragraph as allegedly indefinite;

rejected claims 1-5, 9-14, and 17-22 under 35 U.S.C. § 103(a) as allegedly obvious in view of U.S. Patent Publication 2002/0059127 to Brown et al. ("Brown");

rejected claims 7, 8, 15, 16, and 23-26 under 35 U.S.C. § 103(a) as allegedly obvious over Brown in view of U.S. Patent Publication 2005/0262014 to Fickes ("Fickes")

rejected claim 27 under 35 U.S.C. § 103(a) as allegedly obvious over Brown in view of Fickes in further view of U.S. Patent Publication 2004/0158479 to Adhikari ("Adhikari"); and

rejected claim 28 under 35 U.S.C. § 103(a) as allegedly obvious over Brown in view of Fickes and Adhikari, in further view of Official Notice.

Claims 1-5 and 7-28 are pending in this application. Applicant proposes to amend claim 25 in a manner consistent with the Examiner's helpful suggestion. Applicant submits no new matter is added by this amendment and that no new search is necessitated by this amendment.

As a preliminary matter, the Examiner indicated in the Final Office Action that a document "filed at USPTO on 25 February 2008" is in German and he would not

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

consider the Non-Patent Literature. Final Office Action at page 2. The Examiner further stated that the “material does not appear to affect the evaluation on the US [p]atent application and is in turn disregarded.” Id.

Applicant points out that the Information Disclosure Statement in question was filed on August 4, 2005 and only a complimentary copy was provided to the Examiner concurrently with a response to the Office Action of December 20, 2007 filed on February 25, 2008. Applicant further notes that an English abstract is provided with the Non-Patent Literature cited in the Information Disclosure Statement and points out that the Examiner has stated he has already considered the Non-Patent Literature document and has found that it “does not appear to affect the evaluation of the US [p]atent application.” Id. Applicant submits disregarding the cited Non-Patent Literature document with the English abstract is improper and requests the Examiner officially acknowledge consideration of the document, and return an initialed copy of the Information Disclosure Statement filed on August 4, 2005 with the next correspondence.

Applicant respectfully traverses the rejection of claims 25 and 27 under 35 U.S.C. § 112 as allegedly indefinite. Claim 25 is proposed to be amended in a manner consistent with that of the Examiner’s interpretation of claim 25 in the Final Office Action. Thus, Applicant believes the rejection of claim 25 to be moot. With respect to claim 27, Applicant points out that claim 27 depends on claim 25. Claim 25 recites, in part, “wherein one action is displaying a calculated impairment price.” Claim 27, due to its dependence on claim 25 therefore incorporates this feature and is not indefinite as

the Office Action suggests. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 25 and 27.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims. For example, Brown does not teach or suggest each and every feature of claim 1 as asserted by the Final Office Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2154. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites, in part, “automatically forming an intermediate variable from the book value and the market value.” Brown does not disclose or suggest at least this feature of claim 1.

The Examiner alleges that Brown discloses “automatically determining a market value for each object [0033] [of Brown, and] automatically forming an intermediate variable from the book value and the market value [0033. Examiner interprets current index value as analogous to Applicant’s intermediate variable]” (brackets original except where underlined). Final Office Action at page 4. This allegation, however, is not correct.

The above identified portion of Brown states, in relevant part, “[t]herefore, to effectively harvest tax losses, each individual account is evaluated for tax losses periodically at a minimum of thirty-one (31) days. Although a tax lost harvest period of thirty-one (31) days is described, it will be apparent to one of ordinary skill in the art that any time frame greater than the time frame established by the wash sale rules can be used. To harvest tax losses, it is necessary initially to determine the present market value of each security in the modeled index in a determine current index values step 22” (emphasis added). Brown paragraph [0033].

Thus, this portion of Brown discloses that the “current index values” are determined by the “[modeled] market value of each security” That is to say, the “current index values” are the “[modeled] market value of each security.” The Final Office Action therefore incorrectly interprets the “current index value” of Brown as constituting the claimed “intermediate variable” recited in claim 1, because Brown discloses a “current index value” is the “modeled market value of each security.” This is in contrast to claim 1, which recites the “intermediate variable” as a feature separate from the “market value.” Since, however, Brown discloses that a “current index value” is determining a market value, Brown does not disclose, or even suggest, the claimed “intermediate variable” as the Final Office Action alleges. The “current index value” and the “market value” in Brown are the same single value. The “current index value” from Brown cannot constitute both the claimed “market value for each object” and the claimed “intermediate variable” at least because there can be nothing “intermediate” about a single value. Furthermore, nothing in Brown discloses or suggests any “intermediate variable.” Nothing about a “current index value” of Brown suggests it could constitute anything that is “intermediate” much less the claimed “intermediate variable.” As such, a *prima facie* case of obviousness has not been established for claim 1 and the rejection of claim 1 should be withdrawn.

Independent claims 9, 17, and 25 contain features similar to those discussed in connection with claim 1. None of Fickes, Adhikari, or Official Notice remedy the deficiencies of Brown as outlined above. Applicant therefore asserts that these claims are allowable for at least the same reasons as claim 1. In instances where the

Examiner has relied on Official Notice, Applicant requests the Examiner provide evidence of each and every assertion made in the Final Office Action.

Dependent claims 2-5, 7, 8, 10-16, 18-24, and 26-28 are allowable for at least the same reasons as the independent claims from which these claims depend.

Applicant respectfully requests the Examiner withdraw the rejections to claims 1-5 and 7-28 under 35 U.S.C. 103 and allow the claims.

CONCLUSION

Applicant respectfully requests that the Examiner consider this response under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. Applicant submits that the proposed amendments of claim 25 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Accordingly, the proposed amendments are proper.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 29, 2008

By:

 For

C. Gregory Gramenopoulos
Reg. No. 36,532

Travis Banta
60.498